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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,780	12/09/2003	Roland Lee Smith	3111	4967

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EXAMINER
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DEPUMPO, DANIEL G

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/731,780

**Applicant(s)**

SMITH, ROLAND LEE

**Examiner**

Daniel G. DePumpo

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

1. In view of the new grounds of rejection of claim 20 which was not necessitated by amendment, this office action is non-final.
2. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows: Declarations under 37 CFR 1.131 of Esther Smith, Karen Smith and Roland Smith have been filed indicating that applicant's invention was built prior to 2002. At page 11 of the remarks, applicant indicates that the invention was completed before July 11, 2002. The Declarations indicate that the inventor's wife and daughter used, or witnessed the use of, the invention prior to 2002. Furthermore, the Declaration of Roland Smith states that he submitted the invention for a patent due to encouragement from friends and relatives. The invention was apparently shown to, and/or used by, various friends and relatives more than one year before the filing date. If this is correct, this public use would appear to constitute a bar to patentability under 35 U.S.C. 102(b). Clarification of this issue is required.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear how the stop can be mounted between itself and the vehicle.

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5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

6. Claims 1-23 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. As discussed above, the invention was shown to, and/or used by, various friends and relatives more than one year before the filing date.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karr in view of Ricles.

Karr teaches a system having the structure substantially as claimed. The device includes a trailer rod 2, a rear mirror tab 3, and a trunk vertical rod/tab 1 which is considered to be “attachable” to a truck lid or tailgate. Karr does not teach the details of the stop. Ricles, however, teaches a stop 20. It would have been obvious to modify the combination, by including a stop as taught by Ricles, to provide protection for the tow vehicle.

9. Claims 1, 4, 5, 6, 7, 13 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sommerfeld in view of Karr and Ricles.

Sommerfeld teaches a device having the structure substantially as claimed. The device includes rear mirror line tab 3 attachable to a rear view mirror (with adhesive col. 4, line 54), and a rear line tab 12 attachable to a rear window. Sommerfeld discloses an indicator 10 on the

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trailer, but it is not a vertical rod. Karr, however teaches a similar system including a rod 2 mountable on a trailer. It would have been obvious to modify Sommerfeld by replacing the indicator 10 with a rod, as taught by Karr, so that the system may be used on a flatbed trailer. Sommerfeld also does not teach a stop. Ricles, however, teaches a stop 20. It would have been obvious to modify the combination, by including a stop as taught by Ricles, to provide protection for the tow vehicle.

10. Claims 2, 3, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr and Ricles as applied to claims 1, 4, 5, 6, 7, 13 and 19 above, and further in view of DeShazer.

As set forth above, the combination teaches substantially all that is claimed, but it is unclear how the rod 2 of Karr is attached. DeShazer, however, teaches a similar device having a common detachable pin 38. It would have been obvious to modify the combination, by mounting the rod to a sleeve using a detachable pin, as taught by DeShazer since such an arrangement would provide a common, inexpensive and secure fastening means.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr, Ricles and DeShazer as applied to claims 2, 3, 11 and 17 above, and further in view of Bohnett.

As set forth above, the combination teaches substantially all that is claimed, but does not teach that the trailer rod is affixed by a magnet. Bohnet, however, teaches a similar device having a trailer rod 27 which is attached by a magnet. It would have been obvious to modify the combination, by using a magnet to mount the trailer rod, as taught by Bohnet, to provide a simple device that can be easily installed and removed.

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12. Claim 9 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr and Ricles as applied to claims 1, 4, 5, 6, 7, 13 and 19 above, and further in view of Law.

As set forth above, the combination teaches substantially all that is claimed, but does not teach a suction cup on the rear tab. Law, however, teaches a similar device including a suction cup on rear tab 34. It would have been obvious to modify the combination by including a suction cup on the rear tab, as taught by Law, to provide a reusable fastener that is easily installed and removed. Law also teaches that the rear tab may be mounted to the trunk. The rear tab is also considered to be attachable to a tailgate. It would have been an obvious rearrangement of parts to mount the tab to a tailgate, or to the trunk as taught by Law.

13. Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr and Ricles as applied to claims 1, 4, 5, 6, 7, 13 and 19 above, and further in view of Tusche.

As set forth above, the combination teaches substantially all that is claimed but does not specifically disclose that they are incorporated into a transparent sheet. Tusche, however discloses alignment tabs that are clear or transparent (col. 5, line 67). It would have been obvious to modify the combination by making the tabs transparent, as taught by Tusche, to minimize interference with the driver's vision (col. 6, lines 1 and 2).

14. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr and Ricles as applied to claims 1, 4, 5, 6, 7, 13 and 19 above, and further in view of Potts.

As set forth above, the combination teaches substantially all that is claimed, but does not teach the use of an L-shaped, or U-shaped attachment assembly. Potts, however, teaches a similar device including an attachment assembly that is both L-shaped and U-shaped. It would have been obvious to modify the combination by including such a bracket, as taught by Potts, to provide a sturdy attaching means that is easy to install and remove. Regarding claim 16, Official Notice is taken that it is notoriously old and well known to provide a threaded connection as a mounting means for a rod. It would have been obvious to provide a threaded arrangement so that no special assembly steps, such as welding or crimping, are required.

15. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Sommerfeld, Karr, Ricles and Law as applied to claims 9 and 21-23 above, and further in view of DeShazer.

As set forth above, the combination teaches substantially all that is claimed, but does not teach that the trailer rod is telescoping and pivotal, or the use of a trunk rod. DeShazer, however teaches a telescoping and pivotal trailer rod 50. It would have been obvious to modify the combination by making the trailer rod telescoping and pivotal, as taught by DeShazer, to provide for adjustability to accommodate different sized vehicles.

16. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel G. DePumpo whose telephone number is 571-272-6643. The examiner can normally be reached on Monday - Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on 571-272-6651. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel G. DePumpo  
Primary Examiner  
Art Unit 3611

dgd  
4/20/05